

bona fide member of the genus. See, for example, *In re Jones*, 958 F2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) and *In re Baird*, 16 F3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994). Applicants recognize that the species in each of these cases was represented by a single compound; however, in the present case, the subgenus is so very small as compared to the genus claimed in the '954 patent that it seems very fair to say that the very large list of substituents that might be present on an alkyl group represented by R⁴ (as designated in the '954 patent) would not focus the attention of the reader on a glyoxal substituent in particular. Thus, the same logic as was brought to bear in *Jones* and *Baird* applies here as well. Nevertheless, to expedite prosecution, a terminal disclaimer is provided.

For completeness, applicants call the attention of the Office to U.S. patent 6,340,685 which issued on an application which was the parent of the application on which '954 issued. The independent claim in the '685 patent is similar to that in '954. However, applicants believe no terminal disclaimer should be required with regard to that patent for the same reasons as those set forth above.

CONCLUSION

All claims, except claim 1, were considered free of the art; claim 1 has been amended to include the limitations of claims 2 and 53, claims that were not rejected. Therefore, it is clear that all claims are free of the art based on this amendment alone. In addition, significant differences between the disclosure of the cited documents and the subject matter of claim 1 have been described above.

The formal rejections have also been addressed by amendment or discussion. Applicants again wish to thank the Examiner for her thoughtfulness and helpfulness in resolving these outstanding issues at the interview. The willingness of the Examiner to discuss these matters with the undersigned and to reach agreement on resolution is most helpful.

The only outstanding basis for rejection is for obviousness-type double-patenting over three pending applications and one issued patent. Terminal disclaimers with respect to Serial Nos. 09/990,187 and 09/989,991 are submitted herewith, although applicants do not agree that the claims in the present case are obvious over the claims in those applications. It has been demonstrated that the claims in Serial No. 10/156,997 are directed to a group of compounds restricted out of the present application, and thus by definition not obviousness-type double-patenting. Reconsideration of a request for a terminal disclaimer with respect to 09/316,761 (now patent 6,589,954) is requested in light of the specific requirement for a glyoxal substituent which is not suggested in this parent case.

In view of the foregoing amendment and remarks, it is believed that the currently pending claims (1, 5-6, 9, 12, 16-36, 39, 42, 45-47 and 49-84) are in a position for allowance and passage of these claims to issue is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 219002029000.

Respectfully submitted,

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